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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|
| 09/761,340      | 01/16/01    | MORROW               | N KMOR116839        |

026389 QM12/1106  
CHRISTENSEN, O CONNOR, JOHNSON, KINDNESS  
1420 FIFTH AVENUE  
SUITE 2800  
SEATTLE WA 98101-2347

EXAMINER

KAVANAUGH, J

ART UNIT

PAPER NUMBER

3728

DATE MAILED:

11/06/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/761,340

Applicant(s)

MORROW ET AL.

Examiner

Ted Kavanaugh

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 57-83 is/are pending in the application.
- 4a) Of the above claim(s) 62-64, 66, 67, 70, 71 and 73-83 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 57-61, 65, 68, 69 and 72 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

1. Claims 62-64,66,67,70-71,73-83 withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 5. Claims 66,67,70,71,73-75 were included in the list above because they clearly don't read on the elected species I (figs. 13-16). Claims 66 and 67 recite locations that are within 2 inches and one inch of each other. Reviewing the specification, it would appear claims 66 and 67 are drawn to the species shown in figure 36, see pg. 16, lines 3-5. Claim 70 and 71, refer to a pulley, which is not shown in the elected embodiment but it shown in the species of figure 37. In claims 73, the cable of the elected embodiment is attached at the guide 140, located in the front of the boot, but does not have means for altering at this location and therefore doesn't read on the elected embodiment. Claims 74 and 75 don't read on the elected embodiment because it doesn't contain an ankle strap secure to said shell member and further comprising a lace.
2. Applicant's election without traverse of species I (figs. 13-16) in Paper No. 5 is acknowledged.

***Information Disclosure Statement***

3. The information disclosure statement filed 5-21-01 fails to provide a copy of the foreign patents (documents F1 thru F8) and the examiner was unable to locate them in

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the parent applicant. Applicant is encouraged to provide a copy of these references so proper consideration may be given.

***Claim Rejections - 35 USC § 112***

4. Claims 58-61,65,68,69,72 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Throughout the claims (claim 58, line 2-3; claim 59; claim 60, lines 2-3; claim 65, lines 3-4; claim 68, lines 2-3 and claims 69) applicant is claiming the forward lean adjustment system with regard to the boot. However, the boot has only been functionally recited, see claim 1, line 1, and therefore the claims are unclear and indefinite.

In claim 65, the phrase "said medial an lateral side" is unclear and indefinite.

Shouldn't "an" be --and--?

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 57-61,65,68,69,72 are rejected under 35 U.S.C. 102(b) as being anticipated by DE 3822113 (Lederer).

Lederer shows a system (see figures 37) have structure substantially as claimed including medial and lateral side cable members (2666M or 2620), a tension adjustment

member (2618), the cable is attached at a forward portion on the side of the boot (2674 and 2646, respectively), an engaging arm including a plural engaging members (2668), and a loop back (see figure 37).

### ***Conclusion***

7. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at (703) 872-9302 and After Finals to (703) 872-9303 (**FORMAL FAXES ONLY**). If the previous Fax numbers are not working use any of the following numbers (703) 305-3579 or (703) 305-3580 or (703) 305-3590. Applicants who authorize charges to a PTO deposit account may also use it for filing papers that require a fee. Please identify Examiner Ted Kavanaugh of Art Unit 3728 at the top of your cover sheet.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, email CustomerService3700@uspto.gov.

Any inquiry concerning the MERITS of this examination from the examiner should be directed to Ted Kavanaugh whose telephone number is (703) 308-1244. The examiner can normally be reached on 6AM - 4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul T Sewell can be reached on (703) 308-2126.


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Other helpful telephone numbers are listed for applicant's benefit.

|                                 |                     |
|---------------------------------|---------------------|
| Allowed Files & Publication     | (703) 305-8322      |
| Assignment Branch               | (703) 308-9287      |
| Certificates of Correction      | (703) 305-8309      |
| Drawing Corrections/Draftsman   | (703) 305-8404/8335 |
| Fee Increase Questions          | (703) 305-5125      |
| Intellectual Property Questions | (703) 305-8217      |
| Petitions/Special Programs      | (703) 305-9282      |
| Terminal Disclaimers            | (703) 305-8408      |

If the information desired is not provided above, or has been changed, please do not call the examiner (this is the latest information provided to him) but the general information help line below.

|                        |   |
|------------------------|---|
| Information Help line  | 1-800-786-9199  |
| Internet PTO-Home Page | <a href="http://www.uspto.gov/">http://www.uspto.gov/</a> |

  
Ted Kavanaugh  
Primary Examiner  
Art Unit 3728

TK  
November 3, 2001

Attachment for PTO-948 (Rev. 03/01, or earlier)  
6/18/01

The below text replaces the pre-printed text under the heading, "Information on How to Effect Drawing Changes," on the back of the PTO-948 (Rev. 03/01, or earlier) form.

INFORMATION ON HOW TO EFFECT DRAWING CHANGES

1. Correction of Informalities -- 37 CFR 1.85

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the Notice of Allowability. Extensions of time may **NOT** be obtained under the provisions of 37 CFR 1.136(a) or (b) for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made other than correction of informalities, unless the examiner has approved the proposed changes.

**Timing of Corrections**

Applicant is required to submit the drawing corrections within the time period set in the attached Office communication. See 37 CFR 1.85(a)

Failure to take corrective action within the set period will result in **ABANDONMENT** of the application.